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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,774	10/12/2005	Bernhard Gleich	DE 030117	2136
24737 7590 05/08/2009 PHILIPS INTELLECTUAL PROPERTY & STANDARDS P.O. BOX 3001 BRIARCLIFF MANOR, NY 10510				
EXAMINER				
GUPTA, VANI				
ART UNIT		PAPER NUMBER		
3768				
MAIL DATE		DELIVERY MODE		
05/08/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/552,774

**Applicant(s)**

GLEICH ET AL.

**Examiner**

VANI GUPTA

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-34 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF 298)  
Paper No(s)/Mail Date \_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 – 9 and 19 – 20, drawn to apparatus and use of apparatus for determining mechanical – elastic – parameters of an examination object.

Group II, claim(s) 10 – 18, drawn to method for determining mechanical – elastic – parameters of an examination object.

Group III, claim(s) 21 – 30, drawn to magnetic gas bubble composition.

Group IV, claim(s) 31, drawn to elastic magnetic particle composition.

Group V, claim(s) 32, drawn to use of magnetic gas bubble composition.

Group VI, claim(s) 33, drawn to magnetic particle composition having a magnetization curve having a step change.

Group VII, claim(s) 34, drawn to use of magnetic particle composition having a magnetization curve having a step change.

2. The inventions listed as Groups I – XII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Groups I and Group II do not meet the unity of invention requirement because the method of Group II requires a component that can introduce “magnetic particles into at least part of an examination area;” which Group I does not have the means to do.

Group I, and groups III, IV, and VI do not meet the unity of invention requirement because Group I is drawn to an apparatus that is unrelated to the composition of Group III; and the composition of Group VI. Group I and Group IV do not meet the unity of invention requirement

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because Group I does not have the means to use (or administer) the magnetic particle composition of Group IV prior the detection of and determination of properties of the composition.

Group I and Group V do not meet the unity of invention requirement because Group I is drawn to an apparatus that does not require the use of magnetic gas bubble composition for purposes of imaging to determine elastic parameters of an examination object, particularly because the apparatus of Group I does not provide specifically the means for imaging.

Group I and Group VIII do not meet the unity of invention requirement because Group I is drawn to an apparatus that does not require the use of magnetic particle composition having a magnetization curve having a step change for purposes of determining elastic parameters of an examination object, because the apparatus can be used to determine the elastic properties of magnetic particle compositions having materially different properties, such as a magnetic particle composition with step change of factor zero.

Group II and Group III do not meet the unity of invention requirement because the method of Group II does not require the magnetic gas bubble composition of Group III comprising a surfactant for localizing magnetic particles at the interface between the gas bubble and liquid medium to perform a step of the method (claim 11), which entails determining that the magnetic particles are present on the surface of gas bubbles or drops of liquid.

Group II, and groups IV and VI do not meet the unity of invention requirement because the method of Group II does not require the particulars of the elastic magnetic particle composition of Group IV, or the particulars of the magnetic particle composition of Group VI, to accomplish the steps of Group II. The method of Group II can be accomplished with a materially different magnetic particle composition with entirely different arrangement and properties of magnetic particles.

Group II, and groups V and VII do not meet the unity of invention requirement because they are drawn to unrelated method and use of composition.

Group III, and groups IV and VI do not meet the unity of invention requirement because they are drawn to unrelated composition compositions.

Group III, and groups V and VII do not meet the unity of invention requirement because they are drawn to unrelated composition and use of compositions.

Group IV, and groups V and VII do not meet the unity of invention requirement because groups IV and V are drawn to unrelated compositions; and groups IV and VII are drawn to unrelated composition and use of composition.

Group V, and groups VI and VII do not meet the unity of invention requirement because groups V and VI are drawn to unrelated use of elastic magnetic particle composition and magnetic gas bubble composition; and groups V and VII are drawn to two unrelated uses of compositions.

Group VI and Group VII do not meet the unity of invention requirement because the magnetic particle composition of Group VI has properties that are different than the magnetic particle composition related to the use of magnetic particle composition of Group VII.

3. A telephone call was made to David Barnes on March 30, 2009 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

4. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined

claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoiner in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoiner.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VANI GUPTA whose telephone number is (571)270-5042. The examiner can normally be reached on Monday - Friday (8:30 am - 5:30 pm; EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-2083. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/V. G./  
Examiner, Art Unit 3768

/Long V Le/  
Supervisory Patent Examiner, Art Unit 3768